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- - REMARKS - -

The present amendment replies to a first Non-Final Office Action dated August 22, 2003. Claims 1-20 are currently pending in the present application. Claims 1, 5, 10 and 20 have been amended to more particularly point out and distinctly claim the invention of the present application. The Examiner requested that the specification be amended to provide a missing a word. The specification has been corrected as requested by the Examiner. No new matter has been introduced by the amendment of Claims 1, 5, 10 and 20 or the correction of the specification

In the Non-Final Office Action, Examiner Rosenberger rejected pending claims 1-3, 5, 7-11, 14-16 and 20 on various grounds. The Applicant responds to each ground of rejection as subsequently recited herein, and requests reconsideration and further examination of the present application under 37 CFR § 1.112:

- A. The paragraph beginning on page 5 line 14 requires correction for missing a word.

Examiner Rosenberger requested that the specification be amended to provide for a missing word at page 5 line 20. The Applicant has amended the specification to correct this inadvertent error.

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- B. Claims 5 and 10 were rejected under 35 U.S.C. §112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Examiner Rosenberger rejected claims 5 and 10 for being unclear because there is no cable claimed and no claimed connection of a cable to any claimed structure. The Applicant has amended claims 5 and 10 to more particularly point out and distinctly claim the subject matter believed to be the invention. Both claims have been amended to provide "a port formed therein, the port allowing a cable access to the lower member chamber". Withdrawal of the rejection under 35 U.S.C. §112, ¶2 of claims 5 and 10 is respectfully requested.

- C. Claims 1-3, 7-9, 11 and 14-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,787,834 to Shoup.

The Applicant has thoroughly considered Examiner Rosenberger's remarks concerning the patentability of claims 1-3, 7-9, 11 and 14-16 over U.S. Patent No. 2,787,834 to Shoup (the Shoup Patent). The Applicant respectfully traverses this 35 U.S.C. §103(a) rejection.

As the Examiner is well aware, in order to make a *prima facie* case of obviousness under § 103(a), all of the *claimed* elements of the invention must be taught or suggested by the prior art (MPEP § 2143.03). Further, obviousness cannot be established by combining or modifying the teachings of prior art to produce the claimed invention, absent some motivation, teaching or suggestion supporting the modification or combination (MPEP § 2143.01). There is no teaching in the cited prior art reference to prompt one of ordinary skill in the art to modify this reference to arrive at the invention as claimed.

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Independent claim 1, as currently amended, claims a fixture for calibrating an instrumented fastener, the fixture including an upper member having a cap member removably attached to the upper member, a lower member positioned adjacent the cap member to define a joint, and a removable insert positioned in the lower member opening to receive a lower portion of the fastener.

The Shoup Patent does not teach or suggest, at the least, a joint being defined by a lower member and a cap member of an upper member. For this reason, a finding of obviousness for independent claim 1 over the Shoup Patent is inappropriate. Therefore, independent claim 1 is allowable over the Shoup Patent. The Applicant, thus, requests the withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a).

Claims 2-3, 7-9, 11 and 14-16, depend directly or indirectly from independent claim 1. Therefore, dependent claims 2-3, 7-9, 11 and 14-16 include all of the elements and limitations of independent claim 1. It is therefore respectfully submitted by the Applicants that claims 2-3, 7-9, 11 and 14-16 are allowable over the Shoup Patent for at least the same reason as set forth above with respect to independent claim 1. In view of the above Remarks, withdrawal of the Rejections under 35 U.S.C. § 103(a) for claims 2-3, 7-9, 11 and 14-16 is respectfully requested.

D. Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,601,207 to Steblay.

The Applicant has thoroughly considered Examiner Rosenberger's remarks concerning the patentability of claim 20 over U.S. Patent No. 4,601,207 to Steblay (the Steblay Patent). The Applicant respectfully traverses this 35 U.S.C. §103(a) rejection.

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As the Examiner is well aware, in order to make a *prima facie* case of obviousness under § 103(a), all of the *claimed* elements of the invention must be taught or suggested by the prior art (MPEP § 2143.03). Further, obviousness cannot be established by combining or modifying the teachings of prior art to produce the claimed invention, absent some motivation, teaching or suggestion supporting the modification or combination (MPEP § 2143.01). There is no teaching in the cited prior art reference to prompt one of ordinary skill in the art to modify this reference to arrive at the invention as claimed.

Independent claim 20, as currently amended, claims a system for calibrating an instrumented fastener, the system including an upper assembly positioned adjacent a lower assembly to define a joint. The Steblay Patent does not teach or suggest this limitation as claimed by the Applicant. For this reason, a finding of obviousness for independent claim 20 over the Stebaly Patent is inappropriate.

Therefore, independent claim 20 is allowable over the Steblay Patent. The Applicant, thus, requests the withdrawal of the rejection of claim 20 under 35 U.S.C. § 103(a).

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SUMMARY

Examiner Rosenberger's 35 U.S.C. §§ 112, and 103(a) rejections of claims 1-3, 5, 7-11, 14-16 and 20 have been obviated by the above amendments and remarks. The Applicants respectfully submit that claims 1-20 fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing amendments and remarks, favorable consideration and early passage to issue of the present application are respectfully requested.

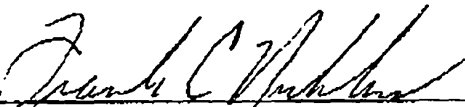
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